REMARKS

Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. § 103 as being unpatentable over Raveis, Jr. US 2001/0047282 A1 in view of Hoyt et al. (U.S. pat. No. 6,067,531). This rejection is respectfully traversed.

The present invention of Claim 1 is directed to a system for generating a contract between at least one seller and at least one buyer. Included in such system is a computer for (1) storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract, (2) storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules, (3) generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and (4) interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract. The invention of Claim 1 is thus directed to a synergistic co-action of elements, including a compilation of business rules and a terms and conditions set corresponding to selected rules from the compilation of rules, that are *linked and interlocked together*, offering component granularity that can easily be modified or adapted to support a plurality of different business models or workflows, and in addition allows flexible access control of the resulting generated entities.

With respect to Claim 1 (and dependent Claims 2-6), Appellants urge that none of the cited references teach or suggest the claimed feature of "storing at least one terms and conditions set *containing parameters corresponding to selected rules from the compilation of business rules*". In rejecting Claim 1, the Examiner alleges that the cited Hoyt reference teaches

"an automated contract negotiator/generation system/method in which multiple users, coupled by a computer network, access a contract database

containing multiple contracts with multiple contract components therein.
A client applet facilitates user input at the client system and assists in a
standardization of legal phrasing and contract negotiation. The client
applet enforces business rules to qualify a contract for expedited approval
(see, abstract, col 1, lines 5-47, col 2, lines 12-56)."

Applicants urge that this broad generalization does not establish any teaching or
suggestion of the specific claimed feature of "storing at least one terms and conditions set
containing parameters corresponding to selected rules from the compilation of business
rules". This claimed feature advantageously provides an ability for logic associated with
the business rules to use execution parameters. For example, if the business rules contain
logic to determine a discounted price, the corresponding terms and conditions instance in
the terms and conditions set would set the discount percentage (Specification page 16,
lines 4-7). Claim 1 is thus shown to have been erroneously rejected as there is at least
one missing claimed element not taught or suggested by the cited references

Further with respect to Claim 1 (and dependent Claims 2-6), Appellants urge that
none of the cited references teach or suggest the claimed feature of _generating links_
between (1) the compilation of business rules and (2) the terms and conditions set to
generate specific terms and conditions to be embodied in the contract. This claimed link
generating step allows for generation of specific terms and conditions using the business
rules, thus advantageously providing a hierarchical relationship where business rules for
an entire business can be defined/described in the business rules, which can then be
customized to generate specific terms and conditions for a contract (Specification page
16, lines 8-11; FIG. 3). In rejecting this claimed feature, the Examiner cites Raveis pages
7-12 as teaching "generating links between the contract". Appellants show that Claim 1
does not merely recite "generating links between the contract", but rather recites that
these generated links are between (i) the compilation of business rules, and (ii) the terms
and conditions set. Thus, the links are between multiple recited items – the business rules
and the terms/conditions set. A mere assertion of _links between a contract_ does not
establish any teaching or suggestion of _links between business rules and a terms and_
conditions set. Thus, the Examiner has failed to establish a prima facie showing of

obviousness with respect to Claim 1, and the burden has not shifted to Applicants to rebut this improper obviousness assertion [1]. In addition, since a prima facie case of obviousness has not been made, the rejection of Claim 1 is improper[2]. Claim 1 is thus further shown to have been erroneously rejected as there is at least one additional missing claimed element not taught or suggested by the cited references.

Still further with respect to Claim 1, there is no teaching or suggestion of the claimed step of "interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract". In rejecting this aspect of Claim 1, the Examiner states that Raveis teaches "interlocking the links to lock the contract" at col. 7, lines 26-42, and that "it is obvious to realize that all contracts have a locking date or process, specifically, real estate contracts". Applicants show multiple errors in such assertion with respect to Claim 1. First, as shown above, the cited reference does not teach or suggest the claimed "links" between the business rules and terms and conditions, so it therefore cannot teach or suggest an interlocking step which uses such (non-existent) links. Secondly, a mere assertion of a teaching of "interlocking the links to lock the contract" does not establish a teaching or suggestion of interlocking (i) the compilation of business rules, (ii) the terms and conditions set *and* (iii) the links to lock the contract, as explicitly recited in Claim 1. Thus, the Examiner is further shown to have failed to establish a prima facie showing of obviousness with respect to Claim 1, as there are missing claimed features not alleged to be taught or suggested by the cited references. Therefore, Claim 1 is still further shown to have been erroneously rejected by the Examiner.

Applicants initially traverse the rejection of Claims 2-6 for reasons given above with respect to Claim 1 (of which Claims 2-6 depend upon).

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[1] In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (emphasis added by Appellants). *See also. In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

[2] If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Page 13 of 18
Albazz et al. – 09/827,431

Further with respect to Claim 2 (and dependent Claims 3 and 4), Applicants urge that none of the cited references teach or suggest the claimed feature of "the computer further stores at least one product list filter for generating a list of a specified subset of products from a master list of products, and generates links between the product list filter, the terms and conditions set and the master list of products". Nor has the Examiner alleged any such teaching or suggestion. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 2, and the burden has not shifted to Applicants to rebut this improper obviousness assertion. In addition, since a prima facie case of obviousness has not been made, the rejection of Claim 2 (and dependent Claims 3 and 4) is improper.

Still further with respect to Claim 3, Applicants urge that none of the cited references teach or suggest the claimed feature of "the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products". Nor has the Examiner alleged any such teaching or suggestion. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 3, and the burden has not shifted to Applicants to rebut this improper obviousness assertion. In addition, since a prima facie case of obviousness has not been made, the rejection of Claim 3 is improper.

Further with respect to Claim 6, Applicants urge that none of the cited references used in the present rejection (Raveis and Hoyt) teach or suggest any type of contract locking by the implementation of digital signatures. The cited Raveis reference discusses contracts at page 19, paragraph [0221], and there is no mention of either (i) contract locking, or (ii) digital signatures. The cited Hoyt reference discusses use of a special user access mode status indicator that can be used to prevent a user from changing editable data in a contract (col. 2, lines 25-27). There is no teaching or suggestion of multiple digital signatures being used for contract locking. Thus, it is urged that neither Raveis nor Hoyt teach or suggest the claimed feature recited in Claim 6, and thus Claim 6 has been erroneously rejected.

With respect to Claim 7 (and dependent Claims 8-13), Applicants traverse for similar reasons to those given above with respect to Claim 1. Applicants wish to also point out that Claim 7 was rejected under 35 USC 103 using Raveis and Hoyt, and yet the

detailed discussion in the rejection makes mention of Shkedy and Hoyt, so Applicants are unclear as to the specific basis for the rejection of Claim 7. Further clarification is requested.

Further with respect to Claim 8 (and dependent Claims 9 and 10), Applicants traverse for similar reasons to the further reasons given above with respect to Claim 2.

Further with respect to Claim 9, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 3.

Further with respect to Claim 12, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 6.

With respect to Claim 14 (and dependent Claim 16), Applicants urge that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, any type of *post-contract processing*. Specifically, there is no teaching or suggestion, or alleged teaching or suggestion, of "A system for *conducting a contractual activity* over a computer network *pursuant to a contract* between at least one seller and at least one buyer, the contract comprising a predefined set of terms and conditions". In addition, Applicants urge that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed features of "wherein the communications interface *displays selected information based on terms and conditions in the contract*", or a computer for "receiving the information and *referencing the terms and conditions of the contract to process the information*". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 14, the burden has not shifted to Appellants to rebut an obviousness assertion, and the rejection of Claim 14 (and dependent Claim 16) is thus improper as a prima facie case of obviousness has not been made.

Applicants traverse the rejection of Claim 17 (and dependent Claim 19) for similar reasons to those given above with respect to Claim 14.

Applicants traverse the rejection of Claim 20 (and dependent Claims 21-26) for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claim 21 (and dependent Claims 22 and 23) for similar reasons to the further reasons given above with respect to Claim 2.

Further with respect to Claim 22, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 3.

Further with respect to Claim 25, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 6.

With respect to Claim 27 (and dependent Claim 29), Applicants traverse for similar reasons to those given above with respect to Claim 14.

With respect to Claim 30 (and dependent Claims 31-35), Applicants traverse for similar reasons to those given above with respect to Claim 1.

Further with respect to Claim 31 (and dependent Claims 32 and 33), Applicants traverse for similar reasons to the further reasons given above with respect to Claim 2.

Further with respect to Claim 32, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 3.

Further with respect to Claim 35, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 6.

With respect to Claim 36 (and dependent Claim 38), Applicants traverse for similar reasons to those given above with respect to Claim 14.

With respect to Claim 39 (and dependent Claims 40-45), Applicants traverse for similar reasons to those given above with respect to Claim 1.

Further with respect to Claim 40 (and dependent Claims 41 and 42), Applicants traverse for similar reasons to the further reasons given above with respect to Claim 2.

Further with respect to Claim 41, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 3.

Further with respect to Claim 44, Applicants traverse for similar reasons to the further reasons given above with respect to Claim 6.

With respect to Claim 46 (and dependent Claim 48), Applicants traverse for similar reasons to those given above with respect to Claim 14.

Therefore, the rejection of Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. § 103 has been overcome.

B.   The Examiner rejected Claims 6, 25, 35 and 44 under 35 U.S.C. § 103 as being unpatentable over Raveis, Jr. US 2001/0047282 A1 and Hoyt et al. (U.S. Pat. No. 6,067,531) in view of Shkedy (U.S. Pat. No. 6,260,024). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claim 6 for reasons given above with respect to Claim 1 (of which Claim 6 depends upon).

Further with respect to Claim 6, Appellants urge that none of the cited references teach or suggest the claimed feature of "the contract is locked by the implementation of digital signatures". In rejecting Claim 6, the Examiner states that this feature is disclosed by Shkedy figs 2, 12 and 14, specifically signature keys, col 47-67. Appellants first show that the cited Shkedy reference does not have cols 47-67 (the patent ends at col. 32). This discrepancy previously was pointed by Appellants in their previous Response to Office Action filed on June 2, 2004, yet the Examiner continues to maintain this erroneous citation to the reference in the present claim rejection.

As to the assertion with respect to Shkedy Figs 2, 12 and 14, while figure 14 does show use of a key, <u>the key is not used to lock a contract</u>, as claimed. Rather, this Shkedy key is used in conjunction with cryptographic techniques to authenticate the seller's bid (Shkedy Col. 22, lines 47-60). A teaching of bid authentication does not teach or suggest locking of a contract, as authentication does not provide any type of locking, and a bid is not a contract. Thus, Claim 6 is further shown to have been erroneously rejected as there is a missing claimed feature not taught or suggested by the cited references.

Applicants initially traverse the rejection of Claim 25 for reasons given above with respect to Claim 20 (of which Claim 25 depends upon).

Applicants further traverse the rejection of Claim 25 for similar reasons to those given above with respect to Claim 6.

Applicants initially traverse the rejection of Claim 35 for reasons given above with respect to Claim 30 (of which Claim 35 depends upon).

Applicants further traverse the rejection of Claim 35 for similar reasons to those given above with respect to Claim 6.

Applicants initially traverse the rejection of Claim 44 for reasons given above with respect to Claim 39 (of which Claim 44 depends upon).

Applicants further traverse the rejection of Claim 44 for similar reasons to those given above with respect to Claim 6.

Therefore, the rejection of Claims 6, 25, 35 and 44 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claim 12 under 35 U.S.C. § 103 as being unpatentable over Raveis, Jr. US 2001/0047282 A1 and Hoyt et al. (U.S. pat. No. 6,067,531) in view of Shkedy (U.S. Pat. No. 6,260,024). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claim 12 for reasons given above with respect to Claim 7 (of which Claim 12 depends upon).

Applicants further traverse the rejection of Claim 12 for similar reasons to those given above with respect to Claim 6.
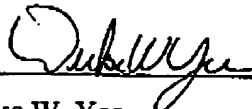
Therefore, the rejection of Claim 12 under 35 U.S.C. § 103 has been overcome.

II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: ___7/13/05___

Respectfully submitted,

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Page 18 of 18
Albazz et al. – 09/827,431